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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,693	07/15/2003	Hiroyuki Kiso	240302US0	7054

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EXAMINER	
COONEY, JOHN M	
ART UNIT	**PAPER NUMBER**
1711	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/618,693	KISO ET AL.	
	Examiner	Art Unit	
	John m. Cooney	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) *5-28* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 29-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's arguments filed 6-8-05 have been fully considered but they are not persuasive.

Rejection under 35 USC 102(b) over Tamano et al. is withdrawn for claims 3-4.

Rejections under 35 USC 102(b)/(e) over Green et al. and Masuda et al., respectively, are withdrawn in light of applicants' amendments and remarks. However, they are retained as being art of interest for their disclosures of relevant catalyst materials. All obviousness-type double patenting rejections are withdrawn in light of applicants' amendments and remarks.

Rejection under 35 USC 102(e) over Kiso et al. is withdrawn in light of applicants' remarks.

The following rejections are maintained or set forth as new in light of applicants' amendments and remarks.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 29, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Tamano et al.(4,910,230).

Tamano et al. disclose catalyst compositions which read on those claimed by applicants (see column 3 line 30 and column 4 lines 48-65, as well as the entire document).

Applicants' amendments and remarks have been considered, but rejection is maintained. Applicants' amendments do not exclude the combination of triethylene diamine with triethylamine as a co-catalyst, and, accordingly, rejection is not overcome.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grier et al.(5,491,174).

Grier et al. discloses combinations of catalysts inclusive of those claimed by applicants (see column 9 lines 47-52, as well as, the entire document).

Grier et al. differs from applicants' claims in that combination and specific amounts are not specified. However, Grier et al. are clear in their recitation of their usefulness as urethanation catalysts. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed mixtures thereof of the recited species

of catalysts as catalysts combinations within the teachings of Grier et al. for the purpose of adequately performing their urethanation catalytic effect in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Further, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller,* 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of similar properties. *Titanium Metals v Banner* 227 USPQ 773. **(see also MPEP 2144.05 I)** Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch,* 617 F.2d 272,205 USPQ 215 (CCPA 1980).

Claims 1-4 and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naka et al.(4,742,089).

Naka et al. discloses combinations of catalysts inclusive of those claimed by applicants (see column 4 lines 35-64, as well as, the entire document).

Naka et al. differs from applicants' claims in that combination and specific amounts are not specified. However, Naka et al. are clear in their recitation of their usefulness as acceptable tertiary amine catalysts. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the one or more tertiary amine catalysts of Naka et al. as catalysts combinations within the teachings of Naka et

al. for the purpose of adequately performing their catalytic function in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Further, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller,* 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of similar properties. *Titanium Metals v Banner* 227 USPQ 773. **(see also MPEP 2144.05 I)** Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch,* 617 F.2d 272,205 USPQ 215 (CCPA 1980).

Claims 1-2,4, 29, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamano et al.(4,910,230).

Tamano et al. discloses combinations of catalysts inclusive of those claimed by applicants (see column 3 line 30 and column 4 lines 48-65, as well as the entire document).

Tamano et al. differs from applicants' claims in that combination with co-catalysts and specific amounts are not specified. However, Tamano et al. are clear in their recitation of their usefulness as acceptable catalyst and co-catalyst combinations. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed triethylene diamine with the tertiary amine co-catalysts, such as triethylamine,

within the teachings of Tamano et al. for the purpose of adequately performing their catalytic function in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Further, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller,* 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of similar properties. *Titanium Metals v Banner* 227 USPQ 773. **(see also MPEP 2144.05 I)** Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch,* 617 F.2d 272,205 USPQ 215 (CCPA 1980).

Applicants' showings of results have been considered but are not seen to demonstrate new or unexpected results which are commensurate in scope with the claims as they stand.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baskent et al. is cited for its disclosure of relevant materials in the art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700